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98-IKU-837

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

SERIAL NO.:	**09/831,334**
FILED:	**January 9, 2002**
FOR:	**ELECTRICALLY CONTROLLED MIRROR FOR A MOTOR VEHICLE**
APPLICANTS:	**ONNO DIRK OENEMA, PAUL WESSEL POST & MARCO RAYMOND MARIA NIJMEIJER**
ART UNIT:	**2872**
EXAMINER:	**MARK A. ROBINSON**
CONFIRMATION #:	**3239**

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5/24/05
Date

Teresa Bonsall

SUPPLEMENTAL APPEAL BRIEF

Sir:

Responsive to the Notification of Non-Compliant Appeal Brief mailed March 29, 2005, Appellants submit this Supplemental Appeal Brief to comply with 37 CFR 41.37.

REAL PARTY IN INTEREST

Eaton Corporation, as Assignee of the entire interest of the present application, is the real party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF THE CLAIMS

Claims 1 through 26 have been cancelled.

Claims 27 through 31 are pending in the Application and stand finally rejected.

STATUS OF AMENDMENTS

Appellants have filed an amendment under 37 CFR 1.116 for the purpose of making corrections suggested by the Examiner.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 27 is directed to an electrically controlled mirror assembly for a motor vehicle. The assembly includes a mirror housing having a build-up element 1 that defines a hollow 3 and that has a reinforcing element molded therein (Figures 1 and 2; page 7, lines 27-33). A base or support 7 supports the build-up element 1 with a electromechanical means, such as a motor 9, that folds or rotates the mirror housing relative to the support (Figure 3; page 8, lines 10-24). The electromechanical means also can adjust a mirror plate 22 relative to the housing (Figure 3; page 7, lines 29-33). An electronics unit is disposed in the hollow 3 to control energization of the electromechanical means (Figure 3; page 9, lines 23-35).

Independent claim 31 is directed to a method of making an electrically controlled mirror by providing a support 7, forming a mirror housing with a single build-up element 1 having a hollow 3 and a reinforcing element, mounting the housing on the support and a mirror on the housing, disposing an electromechanical drive means 9 in the housing for moving the housing and the mirror, and disposing an electronics unit in the hollow for controlling movement of the mirror housing on the support and movement of the mirror on the housing.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(1) Claims 27-30 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,990,999 to Huizenga et al. ("Huizenga") in view of U.S. Patent No. 6,247,823 to Fuerst et al. ("Fuerst").

(2) Claim 31 stands rejected under 35 U.S.C. 103(a) as being obvious over Huizenga in view of Fuerst.

ARGUMENT

(1) Claims 27-30 are patentable under 35 USC 103(a) over Huizenga and Fuerst

The Examiner rejected claims 27-30 as being unpatentable over Huizenga and Fuerst. The Examiner asserted that "the molded conducting strips taught by Huizenga will

inherently provide a degree of reinforcement to the build-up element, thus satisfying the claimed limitation" (Final Rejection, p. 4). Appellant respectfully disagrees.

"The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . . In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. " MPEP 2112.

In this case, the examiner has not provided any reasoning or evidence showing that the electrical leads 68, 70, 72, 74 formed on the housing member 19 in Huizenga necessarily increase the strength and rigidity of the housing element 19. As is known in the art, thin metal conductors, such as wires, are often flexible and not rigid. Moreover, as shown in Figures 8 and 9, the material used for the housing 19 may be made thinner to accommodate the thickness of the electrical leads 74, thereby potentially reducing the strength of the housing 19. The Examiner cannot simply state that the leads 68, 70, 72, 74 increase strength and rigidity like the claimed reinforcement element insert without providing more evidence that these properties necessarily flow from adding the leads, as required by MPEP 2112. At best, the housing 19 acts as a stiffening support for the leads 68, 70, 72, 74, not the other way around (see, e.g., col. 7, lines 38-55). The mere possibility of increased strength and rigidity is not enough to support the rejection of claims 27-30 based on inherency in view of Huizenga's teachings.

The Examiner also admitted that Huizenga does not disclose the claimed electromechanical means or the claimed electronics unit, but argued that it would have been obvious to include an electronics unit in a hollow of a mirror-build-up element as taught by Fuerst to protect the electronics unit. Appellant respectfully disagrees.

There is no motivation to combine Huizenga with Fuerst because the integrally-molded distribution system 66 in Huizenga teaches away from the sealed open chamber 5 structure in Fuerst. "It is improper to combine references where the references teach away from their combination." MPEP 2145.

More particularly, both Huizenga and Fuerst attempt to shield their associated electronics from harsh environmental conditions. Huizenga protects its electrical distribution system 66 by molding the system 66 with the housing member 19 so that the resinous material used for the housing 19 encapsulates the distribution system 66,

leaving no space or gaps for contaminants to enter and preventing the distribution 66 from moving due to vibration (col. 6, lines 46-65). Huizenga emphasizes that conventional actuator systems that do not encapsulate the electrical distribution system are prone to problems caused by vibration and contamination (col. 1, lines 44-65; col. 9, lines 44-61).

Fuerst, by contrast, teaches using a sealed chamber with a lid and emphasizes various sealing structures for the lid without even recognizing that unused space within the sealed chamber would allow the electrical components inside to be jolted by vibrations (Figures 3 through 5; col. 1, line 45 to col. 2, line 12). One of ordinary skill in the art would have viewed Fuerst's structure as completely inappropriate in view of the teachings of Huizenga because the sealed chamber in Fuerst merely encloses the electronic components and does not fill in the gaps inside the chamber to encapsulate the components like Huizenga. Thus, there is no motivation to incorporate the sealed chamber of Fuerst into Huizenga.

Because nor Huizenga nor Fuerst shows the claimed reinforcement element insert in the build-up element, and because there is no motivation to combine Huizenga with Fuerst, the final rejection of claims 27-30 is improper and should be withdrawn.

(2) Claim 31 is patentable under 35 USC 103(a) over Huizenga and Fuerst

Independent method claim 31 recites steps that include insert molding a reinforcement in the build-up element of the mirror housing, disposing an electromechanical drive means on the mirror housing, and disposing an electronics unit in a hollow in the mirror housing. As explained above, neither Huizenga nor Fuerst disclose incorporating a reinforcement element of any kind into a mirror assembly, and there is no motivation to combine Huizenga with Fuerst. The final rejection of claim 31 is therefore improper and should be withdrawn.

Accordingly, it is requested that the Board reverse the Examiner's rejection and allow the claims to be issued.

Respectfully submitted,

Dated: 5/24/05

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APPENDIX

27. An electrically controlled mirror assembly for a motor vehicle comprising:
    (a) a support adapted for mounting on a vehicle;
    (b) a mirror housing moveably associated with said support comprising a single build-up element formed of non-conductive material with a reinforcing element insert molded therein for increasing the rigidity and strength of the build-up element, said build-up element defining a hollow;
    (c) a mirror plate moveably associated with the housing;
    (d) electromechanical means operable upon energization for adjusting said housing relative to said support and for adjusting said mirror plate relative to said housing;
    (e) means operable upon electrical energization for performing an ancillary function; and,
    (f) an electronics unit received in said hollow for controlling said energization for said adjusting.

28. The assembly defined in claim 27, wherein said reinforcing elements comprise electrically conductive strips.

29. The assembly defined in claim 27, wherein said electronic unit includes a printed circuit board.

30. The assembly defined in claim 27, wherein said support includes a mounting base having a hollow shaft adapted for having electrical cables pass therethrough.

31. A method of making an electrically controlled mirror for a motor vehicle comprising:
    (a) providing a support;
    (b) forming a mirror housing comprising a single build-up element of non-conductive material and insert molding therein a reinforcement for increasing rigidity and strength of the build-up element;

(c) forming a hollow in said build-up element;

(d) mounting the housing on the support for movement thereon and mounting a mirror on the housing for movement thereon;

(e) disposing electromechanical drive means on said housing for effecting said movement; and,

(f) disposing an electronics unit in said hollow for controlling the movement of said mirror housing on said support and the movement of said mirror on said housing.